

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GANG-BOCK LEE

Appeal No. 1999-0009
Application No. 08/648,386

HEARD: May 24, 2001

Before FLEMING, LALL, and BARRY, Administrative Patent Judges.
BARRY, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

This is a decision on the appellant's request, (Paper No. 17), that we reconsider our decision in Ex parte Lee, No. 1999-0009 (Bd. Pat. App. & Int. June 20, 2001), which affirmed the rejection of claims 9, 11-15, 17, 19, 20, and 22 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,493,421 (Uetama) in view of U.S. Patent No. 5,420,693 (Horiuchi) further in view of U.S. Patent No. 4,992,884 (Sakata) even further in view of U.S. Patent No. 5,335,085 (Nakatsuma). Our decision also reversed the rejection of claims 1, 7, and 8 under § 103(a) as being obvious over Uetama in view of Horiuchi;

the rejection of claim 2 under § 103(a) as being obvious over Uetama in view of Horiuchi further in view of Nakatsuma; the rejection of claim 3 under § 103(a) as being obvious over Uetama in view of Horiuchi further in view of Sakata; the rejection of claims 4-6, 10, 16, 18, and 21 under § 103(a) as being obvious over Uetama in view of Horiuchi further in view of Sakata even further in view of Nakatsuma; and the rejection of claims 24-31 as being obvious over Uetama in view of Sakata and Nakatsuma.

Rather than reiterate appellant's arguments in toto, we refer the reader to the request for the details thereof. After reconsidering our original decision in light of the arguments, we are persuaded of error therein regarding the nonobviousness of claims 9, 11-15, 17, 19, 20, and 22. Therefore, we grant the appellant's request. We consider the following claims:

- claims 9, 11-14, and 22
- claims 15, 17, 19, and 20
- claim 23.

We begin with claims 9, 11-14, and 22.

I. Claims 9, 11-14, and 22

The examiner asserts, "[s]ince Uetama serves the same purpose as that served by the claimed invention, i.e., stop or

omit printing the unwanted excess data, it would have been

obvious ... to applied [sic] the idea of Uetama to avoid printing excess black data, since black and blank are the two opposition conventions used in image printing and having too much of any kind of the two means the whole document image will not be properly printed." (Final Rejection at 3.) Noting that "the board held that the following limitations: 'determining whether the stored image data contains a predetermined number of sequential lines of black data; and stopping the print operation and displaying a print stop message, when said predetermined number of sequential lines of black data has been determined to have been stored in said memory,' ... were not taught by the applied art," (Req. Reh'g at 10), the appellant argues, "[t]he foregoing limitations are also found in claims [sic] 9." (Id.)

Claims 9, 11-14, and 22 specify in pertinent part the following limitations: "determining whether the stored image data contains a predetermined number of sequential lines of black data; and stopping the print operation and displaying a print stop message, when said predetermined number of sequential lines of black data has been determined to have been stored in said

memory." Accordingly, the claims require inter alia preventing a

facsimile machine from printing when a predetermined number of sequential lines of black data have been stored in its memory.

The examiner fails to show a teaching or suggestion of the limitations in the applied prior art. "'A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.'" In re Bell, 991 F.2d 781, 782, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 147 (CCPA 1976)).

Here, although Uetama teaches "[a] facsimile apparatus capable of economizing the recording paper[,]" col. 1, ll. 8-9, the reference does not prevent the apparatus from printing when a predetermined number of sequential lines of black data have been stored in its memory. To the contrary, Uetama prints marginal, compressed data when a predetermined number of sequential lines of blank data have been received by the apparatus. Specifically, "in the case where a predetermined number of lines of total blank

line data is [sic] received successively, subsequently successive total blank line data are not printed but what is called the

marginal portion is printed by compression. As a consequence, the unrequired [sic] marginal portion in the original is deleted for printing, thereby conserving the amount of recording paper consumption." Col. 4, ll. 27-33. The addition of Horiuchi, Sakata, and Nakatsuma does not cure the defect of Uetama.

Because Uetama prints marginal, compressed data when a predetermined number of sequential lines of blank data have been received, we are not persuaded that the teachings from the applied prior art would have suggested the limitations of "determining whether the stored image data contains a predetermined number of sequential lines of black data; and stopping the print operation and displaying a print stop message, when said predetermined number of sequential lines of black data has been determined to have been stored in said memory." Therefore, we reverse the rejection of claims 9, 11-14, and 22 as being obvious over Uetama in view of Horiuchi further in view of Sakata even further in view of Nakatsuma. We proceed to

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claims 15, 17, 19, and 20.

II. Claims 15, 17, 19, and 20

The examiner asserts, "Nakatsuma teaches setting up a mode such that when the mode is activated, printing of image data other than the report image data is not allowed, which serves the same purpose as that of the claimed invention wherein when an operation mode (the black data reception stop mode) is set and has been determined activated, printing of other image data is not allowed." (Final Rejection at 5.) The appellant argues, "Uetama does, however desire to print all the black data received." (Req. Reh'g at 13.)

"Claims are not interpreted in a vacuum, but are part of and are read in light of the specification." Slimfold Mfg. Co. v. Kinkead Indus., Inc., 810 F.2d 1113, 1116, 1 USPQ2d 1563, 1566 (Fed. Cir. 1987) (citing Hybritech Inc. v. Monoclonal Anti-bodies, Inc., 802 F.2d 1367, 1385, 231 USPQ 81, 94-95 (Fed. Cir. 1986); In re Mattison, 509 F.2d 563, 565, 184 USPQ 484, 486 (CCPA 1975)). Here, claims 15, 17, 19, and 20 specify in

pertinent part the following limitations: "determining whether a black data reception stop mode has been activated while scanning said image data on said document; printing the image data scanned during said scanning step when said black data reception stop mode has not been activated."

The specification describes the black data reception stop mode as follows.

Following step 206 of storing received or copied image data in memory unit 20, central processing unit 10 detects, step 207, whether a sequential predetermined number of lines, *i.e.*, a whole page or half a page of stored image data, is black data. Here, black data is [sic] intended to be detected by page unit (*e.g.*, one page), but it can be detected by line unit (*e.g.*, 3 lines, 5 lines, or more). When central processing unit 10 determines that the number of lines of black data stored in memory unit 20 is not more than the predetermined number of lines, the image data is read from memory unit 20 and provided to printer 70 to be printed, step 209, in a normal printing operation. On the other hand, when central processing unit 10 determines in step 207 that the number of lines of black data stored in memory unit 20 is more than the predetermined number of lines, central processing unit 10 proceeds to step 208. In step 208, central processing unit 10 controls printer 70 to print image data corresponding to a quarter of one page of stored image data as black data and the rest as white data.

(Spec. at 8-9.) Reading claims 15, 17, 19, and 20 in light of the specification, the limitations require inter alia

deactivating a mode for preventing a facsimile machine from printing when a predetermined number of sequential lines of black data have been stored in its memory.

Uetama does not teach a black data reception stop mode that prevents its facsimile apparatus from printing when a predetermined number of sequential lines of black data have been stored in its memory. As explained regarding claims 9, 11-14, and 22, Uetama prints marginal, compressed data when a predetermined number of sequential lines of blank data have been received by the apparatus.

Because Uetama prints marginal, compressed data when a predetermined number of sequential lines of blank data have been received, we are not persuaded that the teachings from the applied prior art would have suggested the limitations of "determining whether a black data reception stop mode has been activated while scanning said image data on said document; printing the image data scanned during said scanning step when said black data reception stop mode has not been activated." Therefore, we reverse the rejection of claims 9, 11-14, and 22 as being obvious over Uetama in view of Horiuchi further in view of

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Sakata even further in view of Nakatsuma. We proceed to claim 23.

III. Claim 23

A rejection not referred to in an examiner's answer is assumed to have been withdrawn. Ex parte Emm, 118 USPQ 180, 181 (Bd. Pat. App. & Int. 1958) (citing Ex parte Charch, 102 USPQ 363, 364 (Bd. Pat. App. & Int. 1954) and Ex parte Hill, 93 USPQ 45, 46 (Bd. Pat. App. & Int. 1952)). Here, although the examiner had finally rejected claim 23, (Final Rejection at 2), he neither repeats nor references the rejection of the claim in his answer. Therefore, we conclude that the rejection of claim 23 under § 103 has been withdrawn.

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CONCLUSION

In summary, we grant the appellant's request to reverse the rejection of claims 9, 11-15, 17, 19, 20, and 22 under § 103(a). The rejection of claims 1-8, 10, 16, 18, 21, and 23-31 under § 103(a), moreover, remain reversed.

GRANTED

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Administrative Patent Judge)	
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)	BOARD OF PATENT
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